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IN THE

Supreme Court of the United States

OCTOBER TERM, 1953.

No. 545

DAYLESS MANUFACTURING COMPANY, INC.
and LESLIE HOFFMAN,

Petitioners,

VS.

ARTMOORE COMPANY
and NILES METALCRAFT COMPANY,

Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT AND BRIEF IN SUPPORT THEREOF.

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MAURICE S. CAYNE,
of Counsel.

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with in accordance with Rule 38 of the Rules of this Court. The decision of the Court of Appeals appears in the record at page 379.* The opinion of the Trial Court appears in the record at page 316 and is reported in 109 F. Supp. 181. 96 U.S.P.Q. 254.

A.

Summary and Short Statement.

1. Respondents Artmoore Company and Niles Metalcraft Company filed suit against Petitioners Dayless Manufacturing Company, Inc. and Leslie Hoffman for infringement of claims 7 and 10 of the Rogers Patent No. 2,108,727 issued February 15, 1938, on a mop.

2. On December 31, 1952 (R. 325) the District Court filed its Findings of Fact and Conclusions of Law holding claims 7 and 10 in issue valid and infringed, and that petitioners were guilty of wanton and wilful infringement. On the same day the District Court entered judgment (R. 332) in favor of respondents.

3. By its judgment (R. 388) dated November 6, 1953, the Court of Appeals for the Seventh Circuit in this case affirmed the portion of the judgment adjudicating the validity and infringement of claims 7 and 10 of Rogers Patent No. 2,108,727 in suit and reversed the portion of the judgment adjudicating wilful and wanton infringement.

4. The patent in suit by its specification (R. 304-305) and drawings (R. 303) discloses, and claims 7 and 10 define, a combination comprising a number of individual elements combined to afford a self wringing mop, each element of which is found in the prior art, and the aggre-

* Such decision also appears in the advance sheets of the United States Patents Quarterly, vol. 99, page 306.

gation of these elements neither performs nor produces a new or different function or operation exceeding the sum of the functions or operations of the sum of the parts.

5. Rogers in his claimed aggregation sought to provide a self wringing mop using a sponge mopping element.

6. The specific combination claimed by Rogers, with all of its inherent alleged advantages is fully disclosed in the prior patent to Kawasaki No. 1,137,760 (R. 353) as may be seen from chart attached opposite page 14 wherein claims 7 and 10 are reproduced in comparison with Fig. 3 (and the other Figures) of the drawings of the Kawasaki prior art patent.

7. Respondents urged and the trial court found that "the key element in plaintiff's (Rogers) disclosure, (is) the rigid frame unit with the fixed spacing of the rollers." (R. 321) This is clearly disclosed in the Kawasaki prior art patent (Rec. 354, Col. 2, lines 91-98) as testified to by defendant's expert (R. 376).

8. The Court of Appeals in this case in rejecting, as the trial court did, petitioner's contention that Kawasaki disclosed the combination defined by claims 7 and 10 in suit, said (Rec. 382).

> "While the defendants at the trial introduced many prior art patents and publications in an attempt to show that the patent in suit was anticipated by the prior art, only five of such patents are relied upon in this court. However, we need mention only three, because they are asserted to be the most pertinent. They are Rogers No. 2,008,615, Kawasaki No. 1,137,-760, and Sanguinet No. 1,352,837, and much stress is laid upon the fact that these three patents were not

cited in the patent office. We have read the oral testimony, examined the documentary evidence and physical exhibits, and we are satisfied that the record supports the findings as made. Any doubt which we might entertain is dispelled by the keen analysis made by the District Court (Judge Perry) of the principles embodied in the patent in suit as well as the teachings of the prior art. We discern no reason to ignore the findings thus made, and certainly we cannot hold that they are clearly erroneous. Having thus concluded, no good purpose could be served by a detailed analysis either of the patent in suit or of the prior art relied upon to anticipate.

"Defendants' argument based on these prior art patents, not cited in the patent office, is not convincing. It has been held, and we think with logic, that it is as reasonable to conclude that a prior art patent not cited was considered and cast aside because not pertinent, as to conclude that it was inadvertently overlooked. *Adler Sign Letter Co.* v. *Wagner Sign Service,* 112 F. 2d 264, 267; *Charles Peckat Mfg. Co.* v. *Jacobs,* 178 F. 2d 794, 802. • • •"

B.

Question Presented.

The decision of the Court of Appeals for the Seventh Circuit presents the following question:

1. Did the Court of Appeals in this case by its decision in holding claims 7 and 10 of the patent in suit valid and infringed depart from the test of invention as announced by decisions of this Court and depart from the well settled rule of law that the citation of more pertinent prior art than that cited by the Examiner destroys the presumption of validity?

C.

Reasons Relied Upon for the Allowance of the Writ.

The reasons relied upon for the allowance of the writ prayed for are:

1. In holding the patent in suit valid, the Court of Appeals for the Seventh Circuit has applied a test of invention which is contrary to the decisions of this Court as well as other Courts of Appeals and disregarded the rule that the citation of pertinent prior art not cited by the Examiner destroys the presumption of validity.

2. The question presented by this petition requires for its determination a pronouncement of what is a proper test of invention, and of the effect on the presumption of validity when pertinent prior art, not cited by the Examiner is called to the Court's attention, thereby constituting a question of great public importance for it not only affects the parties to this litigation but it also affects every member of the public, particularly those dealing or concerned with patents.

3. This question has long been troublesome and perplexing and arises without exception in every patent case in which the validity of the patent is put in issue.

Wherefore, it is respectfully submitted that the writ should issue.

Respectfully submitted,

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January 19, 1954.

IN THE

Supreme Court of the United States

OCTOBER TERM, 1953.

No.

DAYLESS MANUFACTURING COMPANY, INC.
and LESLIE HOFFMAN,

Petitioners,

VS.

ARTMOORE COMPANY
and NILES METALCRAFT COMPANY,

Respondents.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

The writ should issue to free the public of the unjust monopoly which the Court of Appeals has awarded to respondents by applying a test of invention contrary to that laid down in decisions of this Court.

I.

Opinions Below.

The opinion of the District Court is found in the record at page 316 and is reported in 109 F. Supp. 181, 96 U.S.P.Q. 254.

The opinion of the Court of Appeals is found in the record at page 379 and is reported in 99 U.S.P.Q. 306.

II.

Jurisdiction.

Jurisdiction is invoked under Sections 1254 (1) and 2101 (c) of Title 28 of the United States Code.

III.

Statement of Facts.

All of the facts necessary for consideration of the question raised in this case are stated in the accompanying petition for Writ of Certiorari, pages 1 to 5 herein.

IV.

Specification of Errors.

The Court of Appeals erred in sustaining the judgment of the Trial Court adjudging and decreeing claims 7 and 10 of the patent in suit valid.

V.

Argument.

In presenting this petition, your petitioners fully realize that many like petitions have been presented to this Court in the hope and expectation that some definite rule of law may be announced which will serve as a proper criteria of invention; or, that this Court will not hesitate to announce that its decisions in *Cuno Engineering Corp.* v. *Automatic Devices Corporation,* 314 U.S. 84, *Great Atlantic & Pacific Tea Co.* v. *Supermarket,* 340 U.S. 147 and *Crest Specialty* v. *Trager,* 341 U.S. 912 no longer state the test of invention but that the trier of each case shall formulate a test of invention according to the facts presented in such case.

The Court of Appeals for the Seventh Circuit has repeatedly rejected the "flash of genius" test of invention as announced by this Court in *Cuno Engineering* v. *Automatic Devices,* 314 U.S. 84.*

The Trial Court found that the only novel element in the combination covered by the two claims in suit is the frame unit with its rollers at opposite sides in fixed

* **Chicago Steel Foundry Co. v. Burnside Steel Foundry Co.** 132 F. 2d 812, (C.A. 7, 1943); **National Slug Rejectors, Inc. v. A.B.T. Mfg. Co.** 164 F. (2d) 333, (C.A. 7, 1947); **Falkenberg v. Bernard Edward Co.** 175 F. 2d 427 (C.A. 7, 1949); **Peckat Mfg. Co. v. Jacobs,** 178 F. (2d) 794 (C.A. 7, 1949); **Barie v. Superior Tanning Co.** 182 F. 2d 724, (C.A. 7, 1950) where Judge Duffy speaking for the Court of Appeals for the Seventh Circuit said at page 727:

> "Plaintiff stresses that in its opinion the Trial Court quoted from **Cuno Engineering Corp. v. Automatic Devices Co.,** 314 U. S. 84, and included the portion containing the unfortunate 'flash of creative genius' phrase. This Court has twice specifically rejected the flash of genius test."

predetermined spaced relation (R. 319) and predicated invention upon its inclusion in an old combination. However this allegedly novel element is found in the Kawasaki prior art patent (R. 354, column 2, lines 92-98). This finding was adopted by the Court of Appeals without an independent appraisal of the prior art. In other words, both the Court of Appeals and the Trial Court in this case found the patent in suit valid despite the fact that every element of the claims in suit read squarely on the prior art Kawasaki patent, as shown in the chart attached opposite page 14, by the simple expedient of disregarding the prior art on the ground "that it is as reasonable to conclude that a prior art patent not cited was considered and cast aside because not pertinent, as to conclude that it was inadvertently overlooked". This holding was reached notwithstanding the fact that the evidence in this case is uncontradicted that the Kawasaki prior art patent is more pertinent than any of the prior art patents cited by the Examiner (R. 209). The presumption of validity was treated as though it were conclusive and this pertinent prior art was completely disregarded. If the Court of Appeals had followed the test of invention as announced by this Court in the *Cuno* case, or in the *A & P* and *Crest Specialty* cases it could have arrived at no other conclusion than that invention over the Kawasaki patent (R. 353) is not spelled out by the two claims in issue. It is apparent also that the Court of Appeals disregarded the test of invention laid down by this Court in the *A & P* case. Just as in the *A & P* case invention was perceived by the lower courts in the addition of an element to an old combination although that element is taught by the prior art.

Just as in the *A & P* case the device covered by the claims performs the same function that the prior art device performs—it washes or cleans a dirty surface.

Just as the *A & P* three-sided rack does "just what any three-sided rack would do on any smooth surface" so the rollers of the mop covered by the claims in suit do what any rollers in a self-wringing mop do—wring or squeeze the mop. So also the rigid frame does what any such rigid frame unit did in the prior art—it mounts the rollers in fixed predetermined spaced relationship. The carrier unit does what any such prior art carrier did—it carries the mopping member. Just as the *A & P* "guide rails keep it from falling or sliding off the counter" so the mounting and reciprocating means (lever) do what any such means of the prior art do—they mount the units and effect the reciprocation of the units.

It is apparent that *Rogers* contributed nothing over the aggregate of the total of the old elements called for by the two claims in issue.

Is there a different criteria for invention among the several Circuit Courts of Appeals? In the language of the Court of Appeals for the Seventh Circuit in the case of *National Slug Rejectors, Inc.* v. *A.B.T. Manufacturing Corporation,* 164 F. 2d 812, is it the rule that

> "one court will reject what another accepts as patentable novelty, solely because of the difference in measuring standards"?

Is the presumption of validity to be given full weight despite the fact that the most pertinent prior art was not cited by the Examiner as was held by the Court of Appeals in this case or is the presumption of validity destroyed under such circumstances as was held by the

Court of Appeals for the Sixth Circuit in the very recent case of *Royal Patent Tool Corp.* v. *Monarch Tool & Mfg. Co.*, 97 U.S.P.Q. 196, 203 F. (2d) 299 (1953).

Is each of the ten Courts of Appeals to have its own test of invention or should this Court lay down a test of invention to be followed by all Courts of Appeals? That is the important question which these petitioners present to this Court for determination.

As the matter now stands among the several Courts of Appeals, if a manufacturer is sued for patent infringement in New York, he finds, from a survey of the decisions of the Court of Appeals for the Second Circuit* that the test of invention is as announced by this Court in the *Cuno* case, *supra,* to wit:

> "* * * the new device, however useful it may be, must reveal the flash of creative genius, not merely the skill of the calling."

and from a survey of the decisions of the Circuit Court of Appeals for the Sixth Circuit** that when pertinent prior art not cited by the Examiner is called to the Court's attention "the presumption of validity does not exist."

On the other hand, if such manufacturer is sued in Chicago, he is informed from a reading of the decisions of the Court of Appeals for the Seventh Circuit that the

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* Weidhaas v. Loew's Inc., et al, 125 F. 2d 545 (C.A. 2). Other courts which have followed the Cuno case are as follows: Anderson Co. et al. v. Lion Products Co., Inc., et al., 127 F. 2d 454 (C.A. 1); Pearson Sanding Mach. Co. v. Williams Furniture Co., 132 F. 2d 55 (C.A. 4); Trabon Engineering Corp. v. Dirkes et al., 136 F. 2d 24 (C.A. 6); Freeman et al. v. Altvater et al., 138 F. 2d 854 (C.A. 8); Standard Cap & Seal Corp. v. Coe, 124 F. 2d 278 (App. D. C.); In re Shortell, 142 F. 2d 292 (C.C.P.A.).

** Royal Patent Tool Corp. v. Monarch Tool & Mfg. Co., 203 F. 2d 299, (1953).

test of invention is to the contrary. Indeed the test of invention as announced by this Court in the *Cuno* case is flatly rejected. As the Court of Appeals for the Seventh Circuit said in *Barie* v. *Superior Tanning Co.*, 182 F. 2d 727:

> "Plaintiff stresses that in its opinion the Trial Court quoted from *Cuno Engineering Corp.* v. *Automatic Devices Co.*, 314 U.S. 84 and included the portion containing the unfortunate 'flash of creative genius' phrase. This Court has twice specifically rejected the flash of genius test. *Chicago Steel Foundry Co.* v. *Burnside Steel Foundry Co.*, 132 F. 2d 812; *Falkenberg* v. *Bernard Edward Co.*, 175 F. 2d 427."

This illustrates in a small but effective way the sharp conflict between the several Courts of Appeals as to what is a proper test of invention and the weight to be accorded the presumption of validity when prior art not cited by the Examiner is called to the Court's attention.

There is no conflict of decisions with respect to the patent in suit. Petitioners frankly state that their hope of obtaining the allowance of their petition is based upon the great importance of the single question presented, as this question affects every manufacturer who seeks to determine whether a patent upon which a charge of infringement is based, spells out invention. It is as much to his interest to know the criteria of invention as it is to the patentee who asserts the charge of infringement.

CONCLUSION.

It as apparent from this brief survey of the law that the decision of the Seventh Circuit Court of Appeals is in apparent conflict with that of this Court, and in direct conflict with that of other Courts, on a question of importance in the law of patents. Wherefore, it is earnestly urged that the petition for a Writ of Certiorari be granted.

Respectfully submitted,

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MAURICE S. CAYNE,
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FEB 17 1954
HAROLD B. WILLEY, Clerk

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DAYLESS MANUFACTURING COMPANY, INC. AND LESLIE HOFFMAN,

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ARTMOORE COMPANY AND NILES METALCRAFT COMPANY,

Respondents.

BRIEF OF RESPONDENTS IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

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Respondents.

BRIEF OF RESPONDENTS IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

To the Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:

PRELIMINARY.

The petition for writ of certiorari is based upon the false premise that the prior art patents cited by the petitioners were disregarded by the Court of Appeals and were more pertinent prior art than that cited by the Examiner, so that the decision of the Court of Appeals, in holding claims 7 and 10 of the patent in suit valid and infringed, departed from the test of invention as announced by decisions of this Court. Petitioners' premise concerning the pertinence of the prior art was specifically rejected by the trial court, and the Court of Appeals also rejected peti-

tioners' premise after reconsideration of the evidence and the exhibits.

Petitioners present no more than the case of a defeated litigant attempting to create grounds for the further review of its case by this Court.

Supplemental Statement of the Matter Involved.

Petitioners state, on page 2 (paragraph 4), that each element of the combination defined by claims 7 and 10 of respondents' patent is found in the prior art, and that no new or different function or operation exceeding the sum of the functions or operations of the sum of the parts is performed or produced by the patented device. Petitioners have advanced this argument throughout this case, and it was denied by the trial court (R. 319, 322) and by the Court of Appeals. (R. 382.)

On page 3 of the petition (paragraph 6), it is stated that the specific combination claimed by Rogers and all of its inherent advantages is fully disclosed in the prior patent to Kawasaki No. 1,137,760 (R. 353), and reference is made to a chart opposite page 14 of the petition. This chart was before the trial court and the Court of Appeals (Exhibit 9) and was not accepted at its face value by either of these courts, the Court of Appeals saying:

> "We have read the oral testimony, examined the documentary evidence and physical exhibits, and we are satisfied that the record supports the findings as made." (R. 382.)

Foreword.

A brief analysis of the entire opinion of the Court of Appeals and the fundamental facts of this litigation will clearly show that the question presented by petitioners has no sound basis and presents no special and important reasons why review should be granted.

ARGUMENT.

Respondents contended at trial and upon appeal, and the trial court found and the Court of Appeals affirmed that:

(a) Claims 7 and 10 of the Rogers patent 2,108,727 in suit define novelty and invention over the patent to Kawasaki No. 1,137,760 (R. 329);

(b) The mop of the Rogers patent No. 2,108,727 in suit possesses a number of advantages resulting from the combination and arrangement of the parts thereof, including the novel rigid frame unit with the fixed spacing of the rollers (R. 327); and

(c) The prior art patents cited by petitioners reveal that workers in the art had sought unsuccessfully for at least fifty years to provide a commercially acceptable mop having a wringing attachment provided with wringer rollers. (R. 330.)

The Error of Petitioners' Premise.

Petitioners' question is based upon the false premise that the Kawasaki patent defines every element of the claims in suit of the Rogers patent. Further, petitioners' argument contends erroneously, at page 10, that the evidence in this case is uncontradicted that the Kawasaki prior patent is more pertinent than any of the prior art patents cited by the Examiner. Considering the latter contention first, the fact is that respondents introduced persuasive evidence that the Kawasaki patent does not meet or anticipate the patented structure in suit, does not possess the same combination and arrangement of parts,

and does not produce the same advantages. (R. 233, 234, 238, 239-241.)

The Kawasaki patent was considered by the Court of Appeals in passing on this case. Thus, the Kawasaki patent was mentioned specifically (R. 382), and the Court then affirmed the findings of the trial court concerning it, including the following:

> "22. Kawasaki patent No. 1,137,760, dated May 4, 1915, was not shown ever to have been used for any purpose. It discloses a string mop with levers pivoted to a ring slidable upon a mop handle. The levers mount wringer rollers which are swung toward or away from each other by pivoting of the levers. A spring is required to normally press the wringing rollers toward each other, and therefore the wringing rollers are not maintained in predetermined fixed space relation. A wedge type lock is shown for holding the levers in fixed relation as set, but this lock accommodates change in the spacing of the rollers at the will of the operator or according to variation of the mop element.
>
> "The Kawasaki patent does not disclose a lever to provide mechanical advantage during the wringing operation. Separation of the rollers of the Kawasaki device is required to enable them to move from retracted position to wringing position and to return from the end of their wringing stroke to retracted position. The Kawasaki device does not possess the advantages, nor the structure, nor the mode of operation of the mop of the patent in suit.
>
> "23. Claims 7 and 10 of the Rogers patent No. 2,108,727 in suit define novelty and invention over the patent to Kawasaki No. 1,137,760." (R. 328.)

The trial court further referred to devices made in accordance with Kawasaki patent No. 1,137,760, as follows:

> "27. Devices made in accordance with the Kawasaki patent No. 1,137,760 and the Sanguinet patent No.

1,352,837 were introduced in evidence by the plaintiffs and reveal that the constructions disclosed in those patents are not operative as mops, at least as far as their wringing attachments are concerned." (R. 329.)

The deficiencies of the Kawasaki patent as an operative device and as an anticipation of the patent in suit are discussed in the memorandum of the trial court which states:

> "Both patents disclose that the rollers are urged toward each other by springs. The consequent resilient action leads to the only conclusion that the spacing between the rollers is not fixed, that neither patent discloses a rigid frame unit. Without this element, devices responding to the Kawasaki and the Sanguinet are unable to provide the practical advantages of the patent in suit. These advantages, furthermore, cannot be achieved, as the defendants contend, by substitution of a sponge mop in a Kawasaki or Sanguinet device. As outlined previously, these advtantages are due not to the sponge mop alone, but to the combined operation of the elements. Defendants also insist that Kawasaki and Sanguinet disclose fixed spacing of the rollers. Neither the patents themselves nor the testimony of the defendant's expert witness support this contention." (R. 322.)

Another exaggeration of petitioners is the statement that Rogers contributed nothing over the aggregate of the total of the old elements called for by the two claims in issue. This clearly disregards the specific findings in this case that the patent in suit covers a true and inventive combination and arrangement of parts. The Court of Appeals said:

> "The combination and arrangement of the parts causes them to maintain their proper relation when used for cleaning purposes even though no latches and springs are employed; permits a progressive compressive wringing of the flared part of the sponge between fixed spaced rollers, with the expansion of the sponge

assisting return of the rollers and the operating lever to an inoperative position and also serving to hold the same in inoperative position after release of the lever; and the fixed spacing of the rollers by the rigid frame unit assures a uniform and regulated action over an extended period of time.

"The findings further relate that the patented mop possesses a number of advantages resulting from the combination and arrangement of its parts, and from its novel rigid frame unit providing fixed spacing of the rollers." (R. 381.)

The Court of Appeals also said:

"In any event, both Kawasaki (issued in 1915) and Sanguinet (issued in 1920) have long since expired and, so far as this record discloses, neither during their lifetime nor since their demise have they been used for any purpose until they were brought forth in an effort to invalidate the patent in suit. It is unrealistic to reason that Rogers did nothing more than might be expected of the skilled mechanic, when neither of the owners of such prior art patents nor any member of the public after their expiration discovered that their teachings were worth reducing to practice. Especially is this true in view of the fact that the field was wide open and that Rogers was the first to disclose a sponge rubber mop with a wringing attachment, which was placed in manufacture and on the market. The wide acclaim with which it was received by housewives is proof of its utility and is at least some indication of its novelty. While those of the prior art disclosed without result, Rogers reduced his disclosure to practice, and with success." (R. 382.)

In his memorandum opinion the trial Judge discussed at length the advantages possessed by the device of the Rogers patent. (R. 319, 320.) The findings of fact of the trial court contained the following statement of the advantages of the Rogers device:

"14. Among the advantages possessed by the mop

of Rogers patent No. 2,108,727 in suit are the maintenance of a uniform and regulated wringing action over an extended period of time without need for adjustment or supplemental manual pressure upon the rollers; a self-retracting action in which the mopping sponge serves to assist the return of the wringing member to its retracted position after the wringing is completed; a self-positioning action in which the mopping sponge serves to position the rollers and to hold the elements in firm relation to avoid chattering during use of the mop; a self-protecting relationship of the parts against cutting or shearing of the mopping element resulting from the engagement of the mopping member against the rollers and not against the edges of the metal channel during use; ease of operation due to the mechanical advantage provided by the wringing mechanism; avoidance of wetting of the hands of the user while wringing the mop; and a self-locating action in which the mopping member cannot force itself through the rollers and in which the rollers cannot spread to an extent that necessitates application of supplemental pressure thereto for wringing purposes." (R. 327.)

The Decisions in This Case Applied the Proper Legal Tests.

It is clear that the test from *Great Atlantic & Pacific Tea Co.* v. *Supermarket,* 340 U. S. 147, which the petitioners seek to apply is not proper in the present case because the parts of the Rogers patented device in suit do cooperate to produce results not produced in or taught or suggested by the prior patents, including the Kawasaki patent, and because many advantages are produced by the Rogers patented device as compared to the Kawasaki construction as a result of the particular combination and arrangement of the parts defined in the claims of the Rogers patent.

In deciding this case, the trial court made specific ref-

erence to both *Cuno Engineering Corp.* v *Automatic Devices Corp.*, 314 U. S. 84, and the *A & P* case, *supra*, in its memorandum decision. The trial Judge differentiated those decisions because of the nature of the facts of the present case, and because of the novelty of the combination and arrangement of the parts of the Rogers patented device and the advantages and new and unobvious results which that new combination and arrangement of parts produced. (R. 319.) The Court of Appeals and the trial court properly applied in this case the rule of this court in many previous cases, including *Graver Tank & Mfg. Co., Inc.* v. *Linde Air Products Co.*, 336 U. S. 271, to the effect that a new combination of elements producing new and unobvious results evidences the existence of invention.

The Court of Appeals also followed the provisions of Rule 52a of the Federal Rules of Civil Procedure in refusing to set aside the decision of the trial court in the absence of clear error.

There Is No Conflict of Decisions.

Contrary to the contentions of the petitioners, there is nothing in the decisions of the trial court or the Court of Appeals in this case which evidences that either of these courts observed a different criterion for invention than is observed by other Courts of Appeals. No reference was made by the Court of Appeals in this case to any of the authorities to which the petitioners refer on pages 11 to 13. Therefore, reference to those decisions goes entirely outside of the record in this case and constitutes an effort by petitioners to set up a straw man.

Petitioners' arguments that a different rule of law or a different criterion for invention exists in the Seventh Circuit than in other Circuits is devious and untenable. The particular statement quoted by petitioners on page

11, taken from the case of *National Slug Rejectors, Inc.* v. *A.B.T. Mfg. Corp.*, 164 F. 2d 812, was a part of a discussion by the court in that case preliminary to a consideration of the issues in that case. In considering the issues, the court disposed of the case on the ruling that prior patents cited against the patent in suit did not anticipate the patent in suit and that the patent in suit involved invention over the prior patents. Thus any language of the court mentioning a difference in measuring standards is mere dicta, not establishing any rule of law and not controlling in any subsequent suit. *Cohens* v. *Virginia*, 6 Wheat. 264, 399; 5 L. Ed. 257, 290.

Petitioners next refer to the case of *Royal Patent Tool Corp.* v. *Monarch Tool & Mfg. Co.*, 203 F. 2d 299, in which the Court of Appeals for the Sixth Circuit affirmed the proposition that the presumption of validity attending the grant of a patent does not exist where prior patents, not cited by the Patent Office, embody substantially the same idea as the patent in suit. This rule of law is not peculiar to the Sixth Circuit, although usually it is stated differently. Thus it is usual to refer to proof "overcoming" the presumption of validity, and the rule was stated in *Radio Corp.* v. *Radio Engineering Laboratories*, 293 U. S. 1, as follows:

> "A patent regularly issued, and even more obviously a patent issued after a hearing of all the rival claimants, is presumed to be valid until the presumption has been overcome by convincing evidence of error."

The fallacy in attempting to apply the exception of that principle here is that the Kawasaki patent is *not* pertinent, as previously shown.

Petitioners close their specious argument by mentioning a reference in *Barie* v. *Superior Tanning Co.*, 182 F. 2d 727, to the so-called "flash of creative genius" test stated in *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314

U. S. 84. It is interesting to observe that in the *Barie* case the Court of Appeals for the Seventh Circuit denied the existence of patentable invention because the patents there considered did not involve more than the skill or ingenuity that would be shown by a workman skilled in his line of work. Furthermore, insofar as the doctrine of the *Cuno* case is concerned, it was considered and mentioned in this case, the trial court commenting about it:

> "The difficulty with this position lies in the fact that it is not applicable to the case before the bar." (R. 319.)

The affirmance of the decision of the trial court by the Court of Appeals contains no statement in any way detracting from the above quoted statement of the trial court.

In the case at bar, the Court of Appeals considered the novelty of the combination defined by the claims of the patent in suit, the novel and unobvious advantages and results secured by and flowing from that novel combination, and considered the failure of the cited prior art to meet the structure, the mode of operation and the beneficial results and advantages which the device of the patent in suit produced. In applying this test, it followed the rules earlier laid down by this court in *Graver Tank & Mfg. Co.* v. *Linde Air Products Co.*, 336 U. S. 271, *Goodyear Tire & Rubber Co.* v. *Ray-O-Vac Co.*, 321 U. S. 275, and many other cases.

There is nothing erroneous about the decisions of the Court of Appeals and the trial court in this case. There is nothing about this case which indicates that, had any court in a different circuit passed upon it, a different ruling would have applied. It is clear that the Court of Appeals properly ruled that the finding of the trial court that the patent was valid was sustained by the novelty of struc-

ture, the novelty of cooperative relation of parts, and the novelty of results and advantages which the record reveals is possessed by the device of the patent in suit, so that it could not but say

> "We discern no reason to ignore the findings thus made, and certainly we cannot hold that they are clearly erroneous." (R. 382.)

CONCLUSION.

The question raised by the petition involves no substantial question of law, no matter of great or any public importance, no conflict of decisions, no unsettled questions of law, and no departure by the Court of Appeals from the accepted and usual course of judicial proceedings.

The questions raised by the petition further are based upon premises which are totally erroneous and unsupportable in point of fact.

The petition is wholly without merit and should be denied.

Respectfully submitted,

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